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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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09/837,752

04/17/2001

James D. Bennett

P93-00-AC

8896

7590

11/02/2005

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EXAMINER

KNEPPER, DAVID D

ART UNIT

PAPER NUMBER

2654

DATE MAILED: 11/02/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/837,752

Applicant(s)

BENNETT ET AL

Examiner

David D. Knepper

Art Unit

2654

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 22 August 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 11 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 11 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

1. The Action is in response to applicant's arguments received 22 August 2005.
2. Although a paper was filed by the applicant labeled as an Amendment, it merely repeats claim 11 (Previously Presented). This caused the PTO to assume that the applicant failed to list the amended claims resulting in the notice of 30 Aug 2005 requiring a complete listing of claims. The subsequent filing by the applicant on 6 Oct 2005 listed claims 1-10 (Canceled) and again repeated claim 11 (Previously Presented) as the sole claim. As claims 1-10 were previously canceled (17 April 2001), there was, in fact, no amendment presented.
3. Claim 11 is rejected under 35 USC 103 as being unpatentable over Stentiford (5,384,701) in view of Toma (4,706,212).
4. The applicant is referred to the Office Action of 20 May 2005 in view of further remarks below.

#### **Remarks**

5. Applicant's arguments against the teachings of Stentiford on page 3 do not appear to correspond with any relevant claim language regarding the requirements of "the court reporter or other individual". Stentiford clearly allows text to be input as an alternative from a keyboard (col. 2, lines 32-33). The applicant's claim fails to indicate any particular type of input but is broad enough to encompass any "representations of words".

Applicant's arguments against the teachings of Toma on page 6 are based on the premise that it is not possible to input text fast enough for real time operation. However, the applicant argues precisely the opposite on page 4, indicating that the claimed invention may not be used by

an “average person,” but rather a court reporter or other individual trained to provide real-time transcription. The Office’s position fails to take into consideration the fact that such individual transcribe testimonial proceeding, in real-time, every day. As such, the Office’s suggestion that one cannot input words into Applicants’ system fast enough for real-time translation is blatantly incorrect.” It is noted that the claim fails to have any limitation regarding who is using the device but instead indicates the field of the invention is “during a testimonial proceeding”. However, the above argument indicates that the applicant believes that it is common knowledge to input transcriptions of text in real time. In fact, the Office never took a contrary point of view but merely indicated that the “average person...may be unable to input words fast enough in real-time unless limited to a short sentence or phrase”.

The applicant on pages 4-5 appears to take issue with the Examiner’s phrasing in the previous Office Action (20 May 2005) and in the previous Final Office Action (25 June 2004) regarding the word “require” where the Examiner indicated that “...applicant’s invention requires constant input by a person but Stentiford only requires confirmation of each phrase.” The Examiner clearly stated in the previous Final Office Action on page 4, these arguments “...are directed to details not contained in the claim.” The content of the Examiner’s argument was to point out differences in the methodology disclosed in the applicant’s detailed description about how words are received into a transcription system. However, the applicant is now correct that the Examiner’s use of the word “require” was in error as this word does not appear in Stentiford. Column 2, lines 50-60 of Stentiford indicates that a phrase is confirmed with the user but only enables confirmation in that it indicates to the user which of the phrases in the first store it will translate via a speech synthesizer 7 or text output 8. Stentiford also teaches in column 2,

lines 32-33 that ...alternatively text may be input at an input 5, e.g., form a keyboard (not shown). Thus, the confirmation taught by Stentiford could be as simple as displaying text entered by keyboard for view by the user. The applicant's quotation from the Background of Stentiford on page 5 fails to consider that this is what Stentiford is attempting to improve rather than discussing a problem caused. The applicant also argues that without confirmation, "an accurate translation is impossible." The Examiner can find no statement in Stentiford to substantiate such a holding nor does any particular claim limitation seem relevant to the degree of accuracy that the applicant seems to argue as necessary. The prior art similarly makes no reference whatsoever to the unsubstantiated costs submitted by the applicant's melodramatic statement regarding "...millions of dollars, or even worse yet one's life, may be at stake..." This suggests the need for 100% accuracy, which the applicant's system has clearly not achieved. If this is the standard required by the applicant, then the instant specification is sorely lacking and the proof necessary for enablement under 35 USC 112 would be daunting if not impossible to achieve.

The applicant has added a negative limitation "without requiring confirmation of said representations" such that the antecedent of "said representations" are "words spoken in a first language during a testimonial proceeding". This fails to indicate a further limitation of something that is required and serves merely to prevent the applicant from applying any resulting patent against anything that does perform some sort of confirmation. It fails to address anything taught in the prior art in terms of obviousness. Furthermore, because the applicant fails to teach any details regarding confirmation, the applicant is wholly dependent on prior art definitions or interpretations of this term.

That being said, it should be clear that Stentiford suggests that the use of a confirmation step would help ensure that a phrase was accurately identified for translation. One of ordinary skill would therefore surmise that failure to perform confirmation might result in less accuracy but could not assume that confirmation is required or that the system must wait for confirmation because Stentiford does not specify any required input by the user for confirmation. To the contrary, it appears that Stentiford enables confirmation with an automatic output of speech or text to the user. For example, Stentiford indicates in column 1, lines 67-68 that: The system can be implemented to give the user providing the input confirmation that she/he has been recognized/understood correctly by the system... indicating that it is the system, not the user, that provides confirmation. Furthermore, the term “confirmation” is not claimed by Stentiford indicating that the applicant’s argument that it is required by Stentiford is not accurate because Stentiford crafted claims with limitations broad enough to provide protection for a system or method that does not require any type of confirmation.

Based upon the record thus established, the applicant’s claimed negative limitation would not allow any resulting patent to be enforced against a system or method that provides any form of confirmation during transcription, including the standard practice of sending characters representing a key or combination of keys pressed to a screen for view by the user.

The applicant’s argument on page 4 indicates that the user of the applicant’s invention cannot be an “average person” but is “a court reporter or other individual trained to provide real-time transcription...such individuals transcribe testimonial proceeding, in real-time, every day.” This is the applicant’s description of the abilities required by a user of the system but it must be

noted that this narrow interpretation finds no commensurate claim limitation and will therefore receive no further treatment.

The applicant's arguments on page 6 are improper because they fail to address Toma for the teaching relied upon by the Examiner. While the applicant acknowledges that this reference is cited "to illustrate that it was well-known to perform accurate language translation automatically without requiring confirmation" it fails to make any relevant argument, choosing instead to make the irrelevant statements about the use of particular hardware input and storage which was not relied upon in the rejection. As noted above, the applicant's argument also regarding Stentiford is not accurate in that he teaches that it is obvious to input text manually as an alternative to converting speech to text which shows that those of ordinary skill in the art would find these to be obvious alternatives. Again, the applicant is notified that the claim fails to specify any particular form of input. As long as the applicant persists in presenting such incredibly broad language, the Examiner has no choice but to reject it with prior art showing examples of alternative input upon which the claim reads.

The applicant's arguments on page 7 clearly teach that that the claim language must be rejected. The passage quoted by the applicant indicates that the prior art has capabilities that the instant invention is not capable of but fails to address the broad claim language at issue. The applicant falsifies the record with the statement that "no text in the second language is ever communicated." What Stentiford allows is for a single unit to transmit to one or more units each of which can translate into a desired language. Thus, any of the units will read upon the claimed "translating, in real-time, the text in the first language to text in a second language: and communicating the text in the second language to a terminal". The applicant is apparently trying

to differentiate the apparatus of the prior art over the apparatus on the instant invention. Unfortunately, the applicant has only presented a broadly worded claim towards a method and has made no attempt to present apparatus claims. Method steps must be interpreted broadly as opposed to apparatus or means plus function limitations which could be interpreted more narrowly as functional equivalents of disclosed antecedents. The steps of the method have not been limited to any particular apparatus by location or otherwise. Therefore, it is difficult to find any support for unobviousness of the claim in the applicant's argument. For example, the applicant seems to take issue with the protocol described by Stentiford for communication between his disclosed apparatus elements. What "protocol" does the applicant use for transmitting necessary data between each step of the method? The claim fails to define any protocol and similar fails to state any particular type of data codes whatsoever. Should this lack of specificity require rejections under 35 USC 112, first and second paragraphs or is a broad interpretation proper? It is submitted that a broad interpretation is proper and if the applicant wishes to define over the art of record, he is required to draft claim language defining a narrower protocol.

6. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period



will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

7. Some correspondence may be submitted electronically. See the Office's Internet Web site <http://www.uspto.gov> for additional information.

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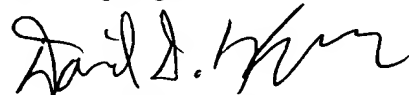
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8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to David D. Knepper whose telephone number is (571) 272-7607. The examiner can normally be reached on Monday-Thursday from 07:30 a.m.-6:00 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Richemond Dorvil, can be reached on (571) 272-7602.

For the Group 2600 receptionist or customer service call (571) 272-2600.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Inquiries regarding the status of submissions relating to an application or questions on the Private PAIR system should be directed to the Electronic Business Center (EBC) at 866-217-9197 (toll-free) or 703-305-3028 between the hours of 6 a.m. and midnight Monday through Friday EST, or by email at [ebc@uspto.gov](mailto:ebc@uspto.gov). For general information about the PAIR system, see <http://pair-direct.uspto.gov>.



David D. Knepper  
Primary Examiner

**Art Unit 2654**

October 26, 2005